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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,682	05/04/2006	Uwe Schnitzler	E7900.2041/P2041	4667
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Washington, DC 20006-5403				
EXAMINER				
SICA, VINCENT C				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/595,682

Applicant(s)

SCHNITZLER, UWE

Examiner

VINCENT SICA

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2009.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-9 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-5 and 7-9 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 04 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

1. In response to the amendment filed on 02/03/2009, claims 1-5 and 7-9 are pending, with claim 9 newly added and claim 6 cancelled. The 35 U.S.C. 112, second paragraph rejections have been withdrawn in view of the amendment.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 9 is rejected under 35 U.S.C. 102(b) as being anticipated by Schnitzler (US Pub. No. 2002/0016590 A1).

Regarding claim 9, Schnitzler teaches an instrument for plasma coagulation in Figs. 1 and 2 comprising a tubular probe body (20) with a tube wall (Fig. 1 cross-section) defining a lumen through which an inert gas is conducted through the probe body (paragraph 0027), an ignition electrode (portion of wire 30 distal to attachment point 31) located within the lumen in the region of an outlet defined by the probe body, a current conductor (portion of wire 30 proximal to attachment point 31) adapted to supply a coagulation current to the ignition electrode, and a fixing device (10) fixing the ignition electrode in a predetermined position within the probe body, and comprising a flat body with longitudinal edges (26) by means of which the flat body is attached to the tube wall such that the flat body extends substantially diametrically across the lumen, and to

which the ignition electrode is attached at a non-distal portion of the ignition electrode (the proximal portion of the electrode is attached at point 31). See paragraph 0026.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-5, 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon et al. (US Pat. No. 5,320,621) in view of Farin et al. (US Pat. No. 5,720,745).

Regarding claim 1, Gordon et al. teaches an instrument for plasma coagulation in Figs. 2, 5 and 6 comprising a tubular probe body (26) with a tube wall defining a lumen (43) through which an inert gas is conducted through the probe body (col. 4, lines 52-57) an ignition electrode (portion of 24 to within and to the right (distal) of fixing device 22) located within the lumen in the region of an outlet defined by the probe body, a

current conductor (portion of 24 to the left (proximal) of fixing device 22) adapted to supply a coagulation current to the ignition electrode, and a fixing device (22) fixing the ignition electrode in a predetermined position within the probe body, and comprising a flat body (legs 42, Fig. 6) with longitudinal edges (between 42 and 40) by means of which the flat body is attached to the tube wall such that the flat body extends substantially diametrically across the lumen, and to which the ignition electrode is attached (col. 4, lines 22-25 and 48-52). Regarding claims 1 and 7, it is noted that Gordon et al. does not explicitly disclose a high-temperature-resistant material within the lumen associated with the flat body. Farin et al. teaches a plasma coagulation device in Fig. 21 with a tubule (20) made of a high-temperature-resistant material (col. 6, lines 43-46) inserted into the lumen in the region of the outlet and wherein conductor (8) is disposed at the proximal (right) end of the tubule that faces away from the outlet (41), wherein the conductor comprises a flat edge (left edge) and abuts the tubule by means of sections of the flat edge. The tubule is secured against the conductor but is removable for sterilization to enable repeated use of the device (col. 6, lines 47-48). Hence, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Gordon et al. with the removable tubule of Farin et al. such that the tubule is removably secured against the flat body in order to enable sterilization of the device for repeated use.

Regarding claim 2 and 3, Gordon teaches the current conductor integrally connected to the ignition electrode by means of the flat body (Figs. 2 and 5)

Regarding claims 4 and 5, Gordon discloses the structural elements of the instrument set forth in claims 4 and : the ignition electrode is attached to the flat body. Although Gordon discloses a physical process used for attaching the electrode in Figs. 8-10, Gordon does not disclose the use of a welded attachment. The procedure for attaching the electrode/conductor to the body in claims 4 and 5 is being treated as a product by process limitation; that is, that the electrode/conductor is attached to the body by point-wise resistance welding. As set forth in MPEP 2113, product by process claims are NOT limited to the manipulations of the recited steps, only to the structure implied by the steps. Thus, even though Gordon does not disclose the use of welding, the final product of Gordon would be the same or similar as that claimed; especially since both applicant's product and the prior art product are electrodes attached to fixing devices used in the delivery of plasma to treat tissue.

Regarding claim 8, Gordon teaches a flat body comprising a flat edge (Fig. 6) that defines a concave cutout (between legs 42) which faces toward the outlet.

7. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon et al. (US Pat. No. 5,320,621) in view of Farin et al. (US Pat. No. 5,720,745), further in view of Schnitzler (2002/0016590 A1).

Regarding claims 4 and 5, it is noted that Gordon does not explicitly disclose welding the electrode or conductor to the flat body. Schnitzler teaches that it is well known to use point-wise resistance welding to attach an electrode/conductor to a flat body (paragraph 0018). It would have been obvious to one of ordinary skill in the art at

the time the invention was made to strengthen the physical attachment between the electrode/conductor and the body using point-wise resistance welding to ensure that the electrode does not slide out from the fixing device.

Response to Arguments

8. Applicant's arguments filed have been fully considered but they are not persuasive. Applicant argues that the flat body 42 of Gordon does not extend "substantially diametrically across the lumen" as recited in claim 1. The examiner notes that this limitation is considered to be broad, as it states "*substantially* diametrically across". The legs 42 of Gordon shown in Fig. 6 extend *substantially* diametrically across the lumen 28 and therefore meet this structural limitation.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VINCENT SICA whose telephone number is (571)270-5531. The examiner can normally be reached on 7:30AM to 5:00PM EST Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571)272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vincent Sica/
04/08/09

/Michael Peffley/
Primary Examiner, Art Unit 3739

